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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,844	12/07/2001	Keizo Uchioke	Q67521	7807

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

LAM, ANDREW H

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/004,844	Applicant(s) UCHIOKE ET AL.	
	Examiner Andrew H. Lam	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 04/26/06.
- Claims 1-17 are pending in the present application. Claims 15-17 are new.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugaya (U.S. Patent No. 6,714,313).

Regarding claim 1, Sugaya discloses an image outputting apparatus (fig. 1, laser beam printer) for printing an image on a recording sheet by using a storage medium (memory 306) in which a plurality of the images are recorded, said storage medium also storing additional information of the respective images (memory 306, col. 11, lines 7-15, print data and attribute data in the external memory as discloses may be recorded on the external memory 317 which may include user name assigned to a given bin as an attribute), said image outputting apparatus comprising: a system controller for classifying said images on the basis of said additional information (fig. 9, attributes information by way of example is considered to be the user name assigned to a bin, col.

10, lines 41-65); a plurality of sorting trays for containing said recording sheet on which said image has been printed (fig. 2, bins 237, 238 and 239), a sorting tray of said plurality of sorting trays (fig. 2) being allocated to each classification of said image by said system controller (fig. 15, bin 1-3 assigned to specific users); and a sorter for discharging said printed recording sheet to said sorting tray (col. 9, lines 1-10, elevating motor 240), said sorter being controlled by said system controller so as to discharge said recording sheet to said sorting tray corresponding to said classification (fig. 10, shows that the classification information is obtained for the memory RAM 306 that matches information obtain from the buffer memory 306a).

Regarding claim 2, Sugaya discloses an image outputting apparatus according to claim 1, wherein said sorting tray is optionally designated to each classification (col. 11, lines 7-15, print data and attribute data in the external memory as discloses may be recorded on the external memory 317 which may include user name assigned to a given bin as an attribute).

Regarding claim 3, Sugaya discloses an image outputting apparatus according to claim 1, further comprising: a displaying member (fig. 15, user interface display) provided so as to correspond to said sorting tray, said displaying member showing said additional information (col. 16, lines 41-45, the information stored has to match the information submitted by the user) used for classifying said images (fig. 15, user assign the bins a specific user or job name).

Regarding claim 4, Sugaya discloses an image outputting apparatus according to claim 3, wherein said displaying member is disposed near said sorting tray (fig. 2, display panel 102).

Regarding claim 5, Sugaya discloses an image outputting apparatus according to claim 3, wherein said displaying member is disposed on said sorting tray itself (examiner considers the selected position as design choices and not particularly a patentable feature).

Regarding claim 15, Sugaya does not disclose expressly the image outputting apparatus according to claim 1, further comprising: a holder for accepting the storage medium, wherein the storage medium is a detachable medium (fig. 3, external memory 317).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6- 14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugaya and well known prior arts (ISO, photography, 11-24-1998) hereinafter ISO.

Regarding claim 6, Sugaya does not disclose expressly an image outputting apparatus according to claim 3, wherein said additional information is photographic information given at the time of taking said image.

ISO discloses additional information is photographic information given at the time of taking said image (ISO, page 16, 4.8, picture annotation).

Sugaya and ISO are combinable because they are from a similar field of endeavor that is image reproduction. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the discharging of recording sheet to plurality of sorting trays as taught by Sugaya based on photographic information given at the time the image was taken. The motivation for doing so would have been to allow the images to be sorted by the original date and time when the image was taken; therefore eases the burden of the user from manually sorting the image after printout.

Regarding claim 7, the combination discloses an image outputting apparatus according to claim 6, wherein said image of said storage medium is taken by an electronic still camera and is recorded thereby (ISO, page 6, removable memory for electronic still camera).

Regarding claim 8, the combination discloses an image outputting apparatus according to claim 7, wherein said additional information is automatically recorded by said electronic still camera (ISO, page 16, 4.8, the date and time information is recorded when an image is taken with the camera).

Regarding claim 9, the combination discloses an image outputting apparatus according to claim 8, wherein said additional information is a photographic date of said image, said images being classified on the basis of said photographic date (ISO, page 16, 4.8 and page 40, 5.2.46).

Regarding claim 10, the combination discloses an image outputting apparatus according to claim 9, wherein said displaying member shows said photographic date (ISO, page 16, 4.8 and page 40, 5.2.46, since the additional information is tagged as taught by ISO when an image is taken by a camera and Sugaya discloses an operational panel display it is obvious that the file can be retrieve by the display).

Regarding claim 11, the combination discloses an image outputting apparatus according to claim 3, wherein said additional information is replay information for replaying said image, said replay information being written in said storage medium after recording said image therein (ISO, page 35, 5.2.43).

Regarding claim 12, the Sugaya does not expressly disclose the image outputting apparatus according to claim 1, wherein said additional information is at least one of a photographer and a photographic condition.

ISO discloses the image outputting apparatus according to claim 1, wherein said additional information is at least one of a photographer and a photographic condition (ISO, page 41, 5.2.49 to page 42, page 52, artist).

Sugaya and ISO are combinable because they are from a similar field of endeavor that is image reproduction. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the discharging of recording sheet to plurality of sorting trays as taught by Sugaya based on photographer and a photographic condition. The motivation for doing so would have been to allow the images to be sorted based on the photographer and a photographic condition; therefore eases the burden of the user from manually sorting the image after printout.

Regarding claim 13, the combination discloses the image outputting apparatus according to claim 12, wherein said photographic condition comprises at least one of exposure conditions and shutter speed (ISO, page 41, 5.2.49 to page 42).

Regarding claim 14, Sugaya does not disclose expressly the image outputting apparatus according to claim 1, wherein said classification is based on at least print size and print resolution.

ISO discloses the image outputting apparatus according to claim 1, wherein said classification is based on at least print size and print resolution (ISO, page 52).

Sugaya and ISO are combinable because they are from a similar field of endeavor that is image reproduction. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the discharging of recording sheet to plurality of sorting trays as taught by Sugaya based print size and resolution. The motivation for doing so would have been to allow the images to be sorted based on the print size and resolution; therefore eases the burden of the user from manually sorting the image after printout.

Regarding claim 16, Sugaya does not disclose expressly the image outputting apparatus according to claim 15, wherein the storage medium is configured to be used in an electronic camera.

ISO discloses a storage medium is configured to be used in an electronic camera (page 6).

Sugaya and ISO are combinable because they are from a similar field of endeavor that is image reproduction. At the time of the invention, it would have been

obvious to a person of ordinary skill in the art to combine the discharging of recording sheet to plurality of sorting trays as taught by Sugaya with using a detachable medium wherein the storage medium is configured to be used in an electronic camera. The motivation for doing so would have been to allow the transfer of files from one source to another.

Regarding claim 17, Sugaya does not disclose expressly the image outputting apparatus according to claim1, wherein each image of the plurality of images is recorded along with the corresponding additional information.

ISO discloses the image outputting apparatus according to claim1, wherein each image of the plurality of images is recorded along with the corresponding additional information (ISO, page 1-6, tagged information with the images).

Sugaya and ISO are combinable because they are from a similar field of endeavor that is image reproduction. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the discharging of recording sheet to plurality of sorting trays as taught by Sugaya with recording corresponding additional information with the image. The motivation for doing so would have been to allow the user to recall the image for later use such as recalling the name of the file.

Response to Arguments

Applicant's arguments on pages 9-12, filed 04/26/06, with respect to the rejection(s) of claim(s) 1-5 under 102(e) and 6-14 under 103(a) have been fully considered and are not persuasive.

Regarding claim 1, the applicant argued the cited prior art (Sugaya) fails to teach and/or suggest "storage of additional information".

In response to applicant's argument Sugaya discloses (col. 16, lines 40-45) that the information such as the user name, printer server name etc. of the print data can be obtain from the RAM 306 which has to correspond to the data submitted from the user which is buffered in RAM 306a, therefore the additional information (user name) is tagged with the print data as shown in step S1001 in figure 10, is exacted to see if the additional information correspond to the information stored on RAM 306.

Contact Information

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Lee

7/8/06

KAWilliams

**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**